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Martin Khang Nguyen

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN

12400 WILSHIRE BOULEVARD

SEVENTH FLOOR

LOS ANGELES, CA 90025-1030

EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

06/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/931,677

Applicant(s)

NGUYEN, MARTIN KHANG

Examiner

Jean Janvier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Response To Applicant's Amendments

The amendments to the specification and the new drawing will not be entered at this time since it appears that they contain new matter. For instance, it appears that the original Application does not refer to any "Super Cheap Store" and a link between the "Super Cheap Store" system and the Retailer's POS system where the coupon is redeemed as featured in new figure 4 (See below for more details).

Response To Applicant's Arguments

First, regarding the specification or the written description, the "Applicant does not convey with reasonable clarity to those skilled in the art" and has herein attempted to clarify the situation by amending the specification, while adding a new drawing. Further, the new amendment to the specification appears to be in opposition with what has been disclosed and claimed thus far. For instance, the second page, line 2, of the new amendment to the specification recites that "The information 460 (contained in the wallet card), however, does not include the coupon data", while claim 4 discloses that the wallet card contains information related to the card transaction **and claim 11 recites that the information comprises a discount coupon** (See also claims 9-10). Additionally, under Patent Law, when an application is filed without drawings, the application is given a filing date based upon the date it was received at the Office. However, if drawings are required in order to help clarify or understand the invention, then the application will be given a filing date based on the date the drawings were received at the Office. The present situation involving the new drawing (fig. 4) appears to be similar to the one described above. Thus, the Examiner cannot approve the new amendment to the specification and the new drawing (fig. 4) for the reasons cited above. Here, the Applicant can overcome the current situation by filing a Continuation-In-Part Application (CIP), which should include the new

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amendment to the specification, the new drawing and any other desired amendments and drawings.

Second, regarding the 112(1) rejection of claims 4 and 7, even the section (i.e. page 9: 7-10 of the specification) cited by the Applicant does not immediately support a issuing to a customer a coupon card that contains or stores information related to coupon card transaction. It is understood that transaction may involve purchase data, product consumed data, documents viewed or read and so on. Here, it appears that the specification does support storing transaction data related to a coupon card that is subsequently issued to a consumer. Further, since this is the first time the coupon card is issued to the customer, it is unlikely that the coupon card will contain any transaction data related to the coupon card since the card has not yet been involved in any transaction or purchase transaction per se.

Moreover, regarding, it appears that the limitations of dependent claims 9 and 11 are not supported under 112(1).

Third, Applicant's arguments are based on limitations that are not necessarily claimed or on limitations, when properly claimed or spelled out, are not supported in the specification under 112(1) (e.g. claims 4 and 7). Here, the Applicant's arguments are broad in nature and offer no specifics since the Applicant simply recites or paraphrases the claims verbatim. In any event, claim 1, for example, recites identifying an advertised coupon for a selected product with a notification indicia related to a wallet card and issuing a purchase discount for the selected product purchased at a retailer upon presentation of the wallet card. **Here, although the specification may provide the appropriate details, however, the link between the advertised coupon, having an indicium or logo printed thereon, and the wallet card is not clear and**

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the usefulness of the wallet card in facilitating the redemption process when the required product is purchased is unclear. In general, although the claims are interpreted in light of the specification, however, limitations from the specification are not read into the claims See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). To this end, the claims limitations are broadly interpreted since the Examiner does not read specific limitations from the specification into the claimed invention.

Indeed, contrary to the Applicant's contention, Fajkowski discloses a system wherein a user joins a service (discount purchase service or clearinghouse) to become a registered customer or member or subscriber and receives a coupon card, which allows him to participate in the coupon distribution system. Coupons, published or advertised from associated sources, are then scanned into the coupon card by the user (subscriber) or downloaded from a plurality of sources including the Internet and a paging system into the coupon card. Subsequently, the user or subscriber takes the coupon card containing the scanned or downloaded coupons to a participating retailer's where one or more stored coupon is retrieved therefrom and redeemed during a synchronization process when the required product is purchased (providing a discount to the user at the POS when the coupon card 1 is presented and the required product is purchased). Needless to say here that the papers coupons, for example, advertised or published via a newspaper source have imprinted thereon logos, images or other notification indicia that represent the featured product or service and/or the manufacturer of the product or provider of the service and, in the end, relate to the coupon card 1 (wallet card) by indicating to the user that those coupons are from one or more participating providers and that they can be scanned into the

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coupon card 1 memory where they are stored for later retrieval and redemption at one or more participating retailers' POSes.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final**.

DETAILED ACTION

Specification

Claim Status

Claims 1-11 are currently pending in the Application.

Claim Objections

Claim 7 is objected to because of the following informalities:

Claim 7 is basically a "data per se", which does not accomplish or yield to any tangible, concrete and useful (meaningful) result (under 35 USC 101). Indeed, the claim simply recites a card containing information in the form of a magnetic medium, which is scanned by a retailer when a consumer purchases an item. No real action has taken place including the action of purchasing the item by the consumer.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 4 and 7 (including their dependent claims if any) are rejected under 35 U.S.C. 112, first paragraph, as based on a lack of disclosure.

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Here, regarding claims 4 and 7, although the specification discloses that the wallet card may contain information, such as the card holder identity, contact information, financial data, privilege level and the like, encoded on a bar code or stored in the memory, nonetheless, it appears that the specification does not immediately support storing transaction information and/or coupon data in the memory of the wallet card before distributing the card to the user.

[Even the section (i.e. page 9: 7-10 of the specification) cited by the Applicant does not immediately support a issuing to a customer a coupon card that contains or stores information related to coupon card transaction. It is understood that transaction may involve purchase data, product consumed data, documents viewed or read and so on. Here, it appears that the specification does support storing transaction data related to a coupon card that is subsequently issued to a consumer. Further, since this is the first time the coupon card is issued to the customer, it is unlikely that the coupon card will contain any transaction data related to the coupon card since the card has not yet been involved in any transaction or purchase transaction per se.]

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski, WO 98/19229.

As per claims 1-11, Fajkowski discloses a system for providing a coupon card or value card (smart card, PDA), from a coupon card issuer, containing one or more coupons or multiple coupons on a single product or service to a customer, who uses the coupon card for redeeming one or more stored coupons during a transaction at a POS or retail establishment, wherein, upon inserting the customer's unique coupon card 1 into the retail establishment periphery device 100 and detecting the presence of at least one stored coupon, scanned or downloaded into the coupon card 1, associated with a product in the customer's order (when a product UPC code stored on the coupon card matches a product UPC code in the customer's order), a price reduction is applied to the customer's transaction and the retail establishment is subsequently credited or reimbursed (receiving payment or paying a rebate to the retailer by the manufacturer related to the redeemed coupon) for honoring or redeeming the at least one coupon retrieved from the customer's **coupon** card 1 (See abstract; page 4: 24 to page 9: 7). Fajkowski further discloses a system wherein during a transaction process, the periphery device 100 indicates if there is a manufacturer instant rebate for any product currently in the customer's order. In the affirmative, the system downloads the instant rebate information in real-time from the manufacturer's server to the POS and allows the customer to instantly receive credit for the rebate, while quickly and efficiently supplying the manufacturer with transaction data including both the demographic data and stimulation power the rebate is intended to

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provide in the first place, wherein the demographic data are used to further measure the effectiveness of the system and to further distribute rebates to the identified user or customer of the coupon card 1 (page 22: 21-24; page 27: 14-31).

Further, Fajkowski discloses that the coupon card (1) may include a customer's identification number, which allows the provider of the coupon card and/or manufacturer (supplier) to uniquely identify each individual user to whom a coupon card 1 is registered, thereby enabling purchase habits or behavior of each individual user to be extracted from collected sale data associated with each user and used by the supplier or manufacturer in further marketing analysis in order to prepare targeted coupon packages for each individual user, wherein the targeted coupon packages are transmitted to each individual coupon card 1, to offer real-time rebates to a user or to increase/decrease a coupon value of a coupon already stored on an identified coupon card 1 (smart card) in **reaction** to the user's response to a current promotion. Here, a **clearinghouse 300 (management establishment or third party)** receives from a plurality of different POS periphery devices 100, linked to servers 200, related to different stores transaction data associated with the users identified by the coupon cards 1 and compiles a detailed database of the purchasing habits or behavior of all users of coupon cards 1. From that database, precise marketing profiles and reports can be provided by the clearinghouse to the manufacturer or supplier and used to generate customized coupon packages by the manufacturer or supplier for the benefit of the individual users of the **coupon cards 1**. In general, coupon data directed to a particular user of a coupon card 1 are transmitted from the manufacturer or supplier to the clearinghouse 300 (manager) to be uploaded by a

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periphery device 100, linked to the clearinghouse 300 (which receives a service fee from the manufacturer or supplier for performing those tasks) via server 200, to the coupon card 1 during a transaction or redemption process at a retail establishment involving the identified coupon card 1. Information on a manufacturer's rebates is supplied to the clearinghouse 300 database and thereby made available to the periphery devices 100 of the various stores. When a periphery device 100 reads the products purchased, by the identified customer bearing the coupon card 1 or smart card, from a store cash register, the periphery device will indicate if there is a manufacturer rebate existing for any of the purchased products. In the affirmative, the rebate information is transmitted in real-time to the periphery device 100 and thus, this paperless rebate system allows the consumer or customer to instantly receive credit for rebates transmitted from the clearinghouse 300 (after the consumer purchases the required products), while quickly and efficiently supplying the manufacturer with both the demographic data and stimulation power the rebate is intended to provide (Page 7: 14-24).

Additionally, the clearinghouse 300 (management establishment providing a service) will use transaction data collected from different periphery devices 100 corresponding to different retailers or servers to generate reports for each manufacturer regarding the amounts for which each retailer is entitled as **reimbursement**. The clearinghouse 300 will also act as a remote database for transferring information to the servers for the use and benefit of retailers, manufacturers and consumers alike and (here, the clearinghouse entity will receive a fee for providing or performing these tasks) (Page 4: 64 to Page 5: 38).

Further, Fajkowski also teaches a system wherein transmission of coupon data to the

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consumer's coupon card 1 (smart card) is conducted by way of digital pager frequency radio waves (transmission of coupon data via a wireless communication). One embodiment of the coupon card may include a radio frequency (wireless) receiver. The consumer would pre-select a group of coupons he wished to receive from the provider of the coupon card service. At a later date, the coupon card service provider would broadcast a pager signal, readable by that consumer's coupon card, which would contain the information corresponding with the pre-selected coupons. The consumer would receive the coupon data, related to the pre-selected coupons, on his coupon card as long as he was anywhere within the range of the pager broadcast (receiving by the consumer via his coupon card e-coupons from a paging or wireless system over a wireless network-Page 8: 33 to page 9: 7). The user can scan paper coupons (publicly published coupons) into the coupon card 1 (coupon wallet card) where the scanned coupon data, related to one or more paper coupons, are stored in permanent memory for later retrieval and usage at a retailer's POS during a redemption process. The coupon data can be also be downloaded from a server, connected to the Internet, to the consumer's coupon card 1 (handset) and stored thereon, following the consumer's request, for subsequent retrieval and use during a redemption process at a participating POS.

(See abstract; page 4: 24 to page 9: 7; page 19: 27 to page 20: 8; page 32: 11 to page 33: 6) and figs. 7a-7b, 9 and 15c.

Finally, the publicly published coupons have imprinted thereon graphics, text, bar code, etc. (page 15: 20-27). **Further**, the publicly published coupons have displayed thereon a marker or a noticeable mark indicating the origin or the source of the coupons and those coupons are

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scanned by the user into the coupon card 1 before they are presented for redemption at retailer's (page 39: 8-25 and claim 6).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 6,354,495B1 to Powell discloses a system for creating, dispensing, and redeeming electronic discount coupons in a store. The system includes a "smart card", product stations adjacent to selected products in the store, and a checkout station in the checkout area. To create an electronic coupon, the customer inserts the card into the product station adjacent to a product the customer wishes to purchase, and the product station then writes an electronic coupon onto the card. The customer thus shops throughout the store collecting electronic coupons for products of interest. Upon completion of shopping, the customer redeems the electronic coupons at the checkout area, by inserting the card into the checkout station. During checkout, when UPC data matches data stored on the card, the customer is credited with the value of the corresponding coupon. Periodically, the electronic coupon data is transferred to a remote clearing house.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

05/25/07

JDJ

JEAN D. JANVIER
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Jean D. Janvier", written in a cursive style.